

Application No. 10/809,595
Paper Dated: November 20, 2007
Attorney Docket No. 3152-063906
PPG Attorney Docket No. 1926A1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No. : 10/809,595
Appellants : Joseph M. Ferencz et al.
Filed : March 25, 2004
Title : Focused Heat Extrusion Process for Manufacturing
Powder Coating Compositions
Group Art Unit : 1732 Confirmation No. : 7249
Examiner : J.M. Wollschlager Customer No. : 24959

MAIL STOP APPEAL BRIEF – PATENTS
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

This Reply Brief is submitted in response to the Examiner's Answer mailed
September 21, 2007.

I hereby certify that this correspondence is being submitted
electronically to MAIL STOP APPEAL BRIEF – PATENTS,
Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-
1450 on November 20, 2007.

Florence P. Trevethan

(Name of Person Submitting Paper)

Florence P. Trevethan 11/20/2007
Signature Date

ARGUMENT

I. Claims 1 and 9 are directed to powder coating production methods.

A. The preambles of claims 1 and 9 should be granted patentable weight.

Appellants have urged that the preambles of claims 1 and 9 be granted patentable weight. The recitations of "manufacturing powder coatings" must be considered to appreciate the claim scope consistent with the specification and prosecution history.

The Examiner has refused to grant patentable weight to the preamble of claims 1 and 9, citing to the MPEP and case law that set forth rules of claim construction. The Examiner's reasoning is only provided in summary form, reproduced below:

The examiner submits that in the instant case, the preambles amount to merely reciting the purpose of a process and do not result in a manipulative difference. The body of the claims are able to stand alone. Accordingly, it is the examiner's position that the preambles are not entitled to patentable weight and that appellant's further arguments against the prior art (i.e. that the references don't teach or suggest "powder coatings") are thereby rendered moot.

Examiner's Answer at 11.

This is merely an automatic determination that the preambles of claims 1 and 9 do not affect the scope of the claims. No reasons are provided for the conclusion that the preambles supposedly only recite a purpose of the processes and do not result in a manipulative difference, nor how the bodies of the claims are supposedly able to stand alone.

The preambles of both claims 1 and 9 do not merely recite the purpose of the respective processes. Claim 1 recites a process "for manufacturing powder

coatings” and claim 9 recites an extrusion process for “manufacturing powder coating compositions”. While both preambles recite a phrase beginning with “for”, the phrases do not mean that the language following “for” is just a desired purpose or intended goal. Both processes are powder coating manufacturing processes. In fact, the preambles could instead read “powder coating manufacturing process powder coatings” and “powder coating composition manufacturing process” with no change in scope.

The preambles do not extol benefits or specify features of the claimed methods. A process “for manufacturing” powder coatings is not merely a purpose or an intended result; it is the invention itself.

Appellants have clearly shown on the record how the preamble of manufacturing powder coatings is a “manipulative difference” in the steps of the claim. Throughout the specification and prosecution history to date, Appellants have only considered the process steps relating to the manufacturing of powder coatings.

Clear reliance on the preamble during prosecution to distinguish an invention from prior art is indicative that the preamble is a claim limitation where such reliance shows use of the preamble to define the invention. *Bristol-Myers Squibb Co. v. Ben Venue Labs, Inc.*, 246 F.3d 1368, 1375, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001). *See also, In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). In *Bristol-Myers*, the patentee asserted a claim to a cancer treatment method where the preamble included the phrase “method for reducing hematologic toxicity”, as well as a claim to a method for treating a cancer patient to “affect regression of a taxol-sensitive tumor, said method being associated with reduced hematologic toxicity”. In that instance, the claim bodies clearly set forth steps of medicating a patient with a particular drug and as such, did not require a preamble (regarding affecting regression of tumors) to understand the meaning of the claims. The court held that the body of the claims (the method steps themselves) could stand alone in that the method steps could be performed regardless of how a patient responded to treatment. The claim language itself suggested

independence of the claim steps from the claim preambles since nothing different would occur if the method steps were performed without regard to the preambles; i.e., the preambles resulted in no manipulated difference in the outcome of the method steps.

In contrast, claims 1 and 9 of the present application do not stand alone; they impact the scope of the claims. The steps listed in claims 1 and 9 are clearly different when read to include the preamble; i.e., the preamble provides a manipulative difference in the claim scope. The steps in claim 1 of feeding, melt mixing and shear mixing a resin and cross-linking agent are different when the resin and cross-linking agent are components of a powder coating composition as opposed to some other composition, such as the ink disclosed by the Williams patent. In claim 9, the extrusion process is distinctly presented for treatment of resin and crosslinking agent to produce a powder coating. The bodies of claims 1 and 9 cannot stand alone without reference to the preamble. The present invention is directed to production of powder coatings, and it is improper to ignore that feature of the claims.

The steps recited in claims 1 and 9 alone do not reflect the invention of manufacturing powder coatings. The bodies of the claims refer to starting materials that are a resin and a cross-linking agent, but the method steps recited in claims 1 and 9 require the preamble in order to give meaning to the entire claim. By reciting "manufacturing powder coatings" and "manufacturing powder coating compositions", Appellants are claiming an advance in manufacturing of powder coating compositions. The recitation of a process "for manufacturing powder coatings" or a process "for manufacturing powder coating compositions" is not merely a purpose of the process, but is the process itself.

B. The phrase "powder coating" is clearly defined in the present application for the purposes of examination.

The Examiner has also considered that, to the extent the preamble is considered a limitation of the claims, the term "powder coating" is not sufficiently defined

in the present application for the purposes of examination and must be interpreted as broadly as reasonably allowed in view of the specification.

Actually, Appellants have already demonstrated on the record how the specification clearly indicates that the powder coating composition of the present invention relates to powder coatings in the conventional sense of producing a powder coating, such as the type that is electrostatically applied to articles including automotive panels, appliance panels and the like. (See pages 5-6 of the Appeal Brief containing excerpts of paragraphs from the specification indicating that the specification clearly only refers to a process of manufacturing powder coatings.) Even though claims 1 and 9 do not include a step of actually applying or using the powder coatings to produce a coating on a panel or the like, the claims are limited to methods of producing powder coatings and powder coating compositions.

The Williams patent is directed to a method of producing an ink composition. Equating producing a powder coating to producing an ink is an inappropriate stretch of the actual teachings of the Williams patent. No person skilled in the art would consider an ink composition that is used to make a marking or printing on a material (whether or not in powder form) to be a "powder coating". A powder coating composition is a composition that is designed to be applied as a coating, which one skilled in the art (and even a lay person) would understand refers to a coating that is applied to and/or spread over a particular surface to cover that surface in multiple dimensions and not as an ink, essentially in a single dimension. As such, the assertion that the Williams method of producing an ink composition also can be interpreted to be a powder coating is inappropriate.

Likewise, WO '916 (Giezen et al.) describes making nanoparticles for use with resin coating applications. To the extent that nanoparticles can be considered to be "powders", the application of nanoparticles is not the creation of a powder coating. A powder coating composition is a composition which is applicable to a surface for

creating a coating thereon. A composition of nanoparticles that can be used in a matrix material is not a powder coating composition.

Accordingly, claims 1 and 9 are directed to methods of producing powder coatings, which define over the cited references that do not even relate to powder coating production processes.

II. The prior art lacks any reason to be modified to practice a process of manufacturing powder coatings by controlling the heat history of the powder coating extrusion.

As detailed in the Appeal Brief, none of WO '916, WO '726 or the Williams patent provides any reason to modify their teachings to control the heat history of a powder coating extrusion. Nothing in WO '916 relating to the production of nanoparticles suggests that there would be a reason to control the heat history thereof. Likewise, the extrusion of polymeric films and tapes described in WO '726 does not relate to producing powder coatings from a resin and a cross-linking agent, and there is no reason to control the heat history and focused heating of the extrusion of polymeric films. The Williams patent is directed to the production of an ink composition and clearly does not provide any reason for controlling the heat history of ink resins produced through an extruder.

Given that none of the cited references even relate to the production of powder coating compositions in an extruder, there is no reason to modify these references to control the heat history experienced in an extruder. Accordingly, claims 3-5, 10, 11 and 14 are non-obvious thereover.

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III. Conclusion

The rejection of claims 1-14 based on references that do not relate to the production of powder coating compositions should be withdrawn. Reversal of the rejections and allowance of claims 1-14 is respectfully requested.

Please direct all correspondence to:

**Diane R. Meyers
PPG Industries, Inc.
One PPG Place
Pittsburgh, Pennsylvania 15272
Telephone: 412-434-2931
Facsimile: 412-434-4292**

Respectfully submitted,


Julie W. Meder
Registration No. 36,216
Attorney for Appellants

PPG Industries, Inc.
One PPG Place
Pittsburgh, PA 15272
Telephone: (412) 434-3798
Facsimile: (412) 434-4292